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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,340	10/17/2003	Yolla B. Levitt	58981US002	7082

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EXAMINER

KUGEL, TIMOTHY J

ART UNIT PAPER NUMBER

1712

DATE MAILED: 08/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/687,340

Applicant(s)

LEVITT ET AL.

Examiner

Timothy J. Kugel

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 25 and 27-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 and 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-29 are pending as amended on 28 June 2006. Claims 25 and 27-29 are withdrawn from consideration.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Election/Restrictions

3. This application contains claims 25 and 27-29 drawn to a nonelected invention. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Specification

4. Applicant is reminded that the lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

5. Applicant is reminded that the use of the trademarks KRATON, TRINITRON, HORIBA, MITSUBISHI, PANASONIC, ACCU-CHEK, RODACAL, SURFYNOL, TAGAT, LAMBENT and ZONYL have been noted in this application. They should be capitalized wherever they appear and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner that might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 112

6. Applicant's amendment, filed 28 June 2006, with respect to clarifying claim 15 and clarifying the dependency of claims 23 and 24 has been fully considered and is corrective.

The rejection of claims 15-24 under 35 USC 112 2nd paragraph has been withdrawn.

Claim Rejections - 35 USC § 102 and/or 35 USC § 103

7. Applicant's amendment, filed 28 June 2006, with respect to the additional limitation in independent claims 1 and 15 that the surfactant composition is dried on the surface has been fully considered and overcomes the prior art.

Further, applicant's statement of common ownership, filed 28 June 2006, has disqualified US Patent 6,908,453 (Fleming hereinafter) as prior art under 35 USC 103(c).

The rejection of claims 1-11, 13-21, 23 under 35 USC 102(e) as being anticipated by, or in the alternative under 35 USC 103(a) as being unpatentable over, Fleming has been withdrawn.

The rejection of claim 26 under 35 USC 103(a) as being unpatentable over, Fleming has been withdrawn.

8. Claim 26 stands rejected under 35 U.S.C. 102(e) as anticipated by Fleming.

Fleming teaches surfaces provided with a hydrophilic coating to enhance fluid transport provided by coating the desired surface or surfaces using a surfactant solution that includes from about 0.05% to about 0.5%, by weight, branched chain sodium dodecylbenzene sulfonate—the elected stabilizer—and from about 0.10% to about 0.6%, by weight, ethoxylated acetylenic diol—the elected surfactant—in a solvent including a 70/30 mix of isopropyl alcohol and water (Column 6 Lines 5-13). The dried coating composition calculates to a 0.2:1 to 12:1 ratio of surfactant to stabilizer.

Since Fleming teaches the same composition as claimed, one of ordinary skill in the art at the time the invention was made would have expected that the results of the Spreading Drop Test, the phase of the surfactant composition at below 25° C, the melting point of the stabilizer and the contact angle on the hydrophilic surface of the Fleming composition would inherently be the same as claimed.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

9. Although not directed to the elected species of surfactant, in the interest of compact prosecution, claims 1, 4, 5, 8-11, 13-17, 20, 21, 23, and 26 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over UK Patent GB 1235918 (Weigel hereinafter). Weigel has been designated as an X reference on the International Search Report for PCT/US2004/032741, which is a continuation of the instant application.

Weigel teaches a coating on a surface (Page 1 Lines 13-17) comprising an anionic surfactant—including the elected species of stabilizer, alkyl aryl sulfonate—and a non-ionic surfactant—including polyoxyalkylene adducts—at concentrations of from 1 to 100 grams/liter—which calculates to 0.1 to 1.0%—in water, wherein the ratio of anionic surfactant to non-ionic surfactant in the dried coating is 1:1 (Page 1 Lines 57-76 and Example 5 Page 4), further, Weigel teaches a heat treatment step that would drive off the water, drying the composition (Page 1 Lines 82-86)..

Since Weigel teaches the same composition as claimed, one of ordinary skill in the art at the time the invention was made would have expected that the results of the Spreading Drop Test, the phase of the surfactant composition at below 25° C, the melting point of the stabilizer and the contact angle on the hydrophilic surface of the Weigel composition would inherently be the same as claimed.

Where applicant claims a composition in terms of a function, property or characteristic and the composition of the prior art is the same as that of the claim but the function is not explicitly disclosed by the reference, the examiner may make a

rejection under both 35 U.S.C. 102 and 103. "There is nothing inconsistent in concurrent rejections for obviousness under 35 U.S.C. 103 and for anticipation under 35 U.S.C. 102." *In re Best*, 562 F.2d 1252, 1255 n.4, 195 USPQ 430, 433 n.4 (CCPA 1977).

10. Although not directed to the elected species the in the interest of compact prosecution, claims 15-18, 20, 23, 24 and 26 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over European Patent EP 1101803 (Kanno hereinafter). Kanno has been designated as an X reference on the International Search Report for PCT/US2004/032741, which is a continuation of the instant application.

Kanno teaches a coating composition for use on substrates such as resin (Abstract, ¶0001) comprising 0.05 to 2% of a surfactant (¶0020) or combination of surfactants (¶0015)—including 1:1 ratios of nonionic surfactants, such as polyoxyalkylene oxides, and fluorosurfactants (¶¶0013-0014 and Example 6 Table 1 Page 8) in water and water soluble solvents such as methanol, ethanol, n- and iso-propyl alcohol, and n-, iso-, s- and t-butyl alcohol (¶¶0021-0024 Examples 1-9 Table 1 Page 8). Further, Kanno teaches that the coating is dried after application (Page 4 Lines 2 and 3).

Since Kanno teaches the same composition as claimed, one of ordinary skill in the art at the time the invention was made would have expected that the results of the Spreading Drop Test, the phase of the surfactant composition at below 25° C, the

melting point of the stabilizer and the contact angle on the hydrophilic surface of the Kanno composition would inherently be the same as claimed.

Where applicant claims a composition in terms of a function, property or characteristic and the composition of the prior art is the same as that of the claim but the function is not explicitly disclosed by the reference, the examiner may make a rejection under both 35 U.S.C. 102 and 103. "There is nothing inconsistent in concurrent rejections for obviousness under 35 U.S.C. 103 and for anticipation under 35 U.S.C. 102." *In re Best*, 562 F.2d 1252, 1255 n.4, 195 USPQ 430, 433 n.4 (CCPA 1977).

11. Claims 1-24 and 26 are rejected under 35 U.S.C. § 103(a) as being unpatentable over US Patent 4,784,789 (Jeschke hereinafter) in view of 6,313,182 (Lassila hereinafter).

Jeschke teaches a composition for treating surfaces (Column 1 Lines 5-12) comprising 0.02 to 5% of an amphoteric polymer (Column 2 Lines 22-48)—including anionic surfactants such as ethoxylated alkenols (Column 3 Lines 19-25)—and a surfactant—including alkylbenzene sulfonates containing 9 to 15 carbons in the alkyl group and alkali metals thereof (Column 3 Lines 31-63) from this which, one of ordinary skill in the art would immediately envisage the alkali metal salt of dodecyl benzene sulfonate—in a 20:1 to 1:1 ratio (Column 2 Lines 22-37) dissolved in water and a water soluble solvent—including C₂-C₁₂ alcohols such as ethanol and isopropanol (Column 5 Lines 8-20 and Example 1 Columns 8 Lines 30-47). Further, Jeschke teaches that the composition is dried after application Column 7 Lines 29-38 and 54-58).

Jeschke does not disclose expressly the use of the elected acetylenic diol ethylene oxide adduct.

Lassila discloses coating compositions comprising acetylenic diol ethylene oxide adducts (Abstract, Column 1 Lines 10-30 and Column 1 Line 39 – Column 2 Line 10).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include the acetylenic diol ethylene oxide adduct of Lassila in the composition of Jeschke. The motivation to do so would have been to take advantage of the significant advantages of the alkoxyated acetylenic diols including the ability to be applied to a variety of substrates, the ability to reduce coating defects, their environmental friendliness, and their capability to control foam (Lassila Column 6 Lines 29-55).

Since Jeschke and Lassila combine to teach the same composition as claimed, one of ordinary skill in the art at the time the invention was made would have expected that the results of the Spreading Drop Test, the phase of the surfactant composition at below 25° C, the melting point of the stabilizer and the contact angle on the hydrophilic surface of the Jeschke/Lassila composition would inherently be the same as claimed.

Response to Arguments

12. Applicant's arguments filed 28 June 2006 have been fully considered but they are not persuasive.

Applicant argues that since Weigel teaches that the dried composition is water-insoluble it is therefore not hydrophilic; however, there is a great difference between

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insolubility and being hydrophobic and the polar groups present in the surfactant compositions—for example, the oxyalkylene groups in the non-ionic surfactant and the sulphonate groups in the anionic surfactants—would impart hydrophilicity even if the composition was insoluble in water.

Applicant further argues that Kanno does not anticipate the claims since the compositions anticipating the claims appear in the comparative examples of Kanno; however, even if Kanno discloses compositions superior to the comparative examples, the comparative examples are still teachings of the reference and therefore still anticipate, or in the alternative make obvious, the instant claims.

Applicant finally argues that Lassila teaches the use of acetylenic diol ethylene oxide adducts in place of nonionic and anionic surfactants; however, while Lassila may teach the superiority of the acetylenic diol ethylene oxide adducts taught there is no teaching that they should replace the nonionic and anionic surfactants. Further, even if Lassila taught a replacement of the nonionic and anionic surfactants with the acetylenic diol ethylene oxide adducts it has been held that it is *prima facie* obviousness to combine two components each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the same purpose. *In Re Kerkhoven*, 205 USPQ 1069, 1072 (CCPA 1980); and *Ex Parte Quadranti*, 25 USPQ2d 1071 (Bd. Pat. App. & Inter. 1992).

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy J. Kugel whose telephone number is (571) 272-1460. The examiner can normally be reached 6:00 AM – 4:30 PM Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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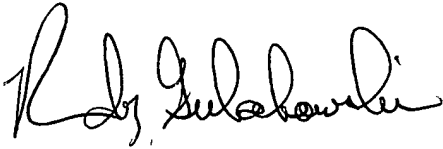
published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

TJK
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